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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,446	11/19/2003	James M. Carroll	638560-27	9845

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/718,446	Applicant(s) CARROLL, JAMES M.	
	Examiner Sue A. Purvis	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-26 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 and 11-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Sinclair (US Patent No. 6,213,184 B1).

Regarding claim 1, Sinclair discloses a tractor mechanism for automatically moving a seaming iron (60) along a seam with a frame configured to retain a seaming iron (60) in a suitable position and a motor connected to the frame to drive the iron to activate the material being seamed. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). The carpet and the seam tape are material worked upon and fail to limit the apparatus claim.

Regarding claim 2, drive wheels (72, 74) are connected to the motor held in the housing (16).

Regarding claim 3, the wheels (72, 74) engage the surface of the material being welded.

Regarding claim 4, the hot wedge (60) is a seaming iron retained in the frame/device.

Regarding claims 5 and 6, Sinclair does not explicitly teach having a detachable connection between the frame and seaming iron or having a connector also be detachable, however components of a system such as the one in Sinclair are known to be attached detachably, because machines are known to have removable components for repair and maintenance reasons. It is reasonable to assume the components of Sinclair can be removed and repaired as needed.

Regarding claim 7, the frame, seen generally in Figures 1 and 2, comprise an integrated housing for the seaming iron and motor.

Regarding claim 8, the wedge in Sinclair is an electrically heated element thus an induction heating tool.

Regarding claims 11 and 12, Sinclair includes a tray and/or a seaming board (24) at the bottom of the frame to receive the seaming iron.

Regarding claims 13 and 14, the motor in Sinclair is capable of being configured to operate at either a fixed or adjustable speed. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Regarding claims 15 through 22, Sinclair includes a control panel (30). Control panel (30) includes on/off switch (32); power indicator light (34); manual/auto switch (36); forward/reverse switch (38); speed control switch (40); programmable temperature control (42); and, fuses (44). The system in Sinclair includes all the structural features as detail in claims 15 through 22. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44

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USPQ2d 1429, 1431-32 (Fed. Cir. 1997). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sinclair.

Regarding claim 5, Sinclair does not teach having a detachable connection between the frame and seaming iron, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a detachable iron, because it is within the purview of the artisan to know the advantages to using a detachable iron. For example, a detachable iron allows the user to more easily clean the iron after its use.

Regarding claim 6, additionally a connector would also be known to be attached removable, to make it simpler to repair the connector if an error occurs with it. Components of a system such as the one in Sinclair are known to be attached removably, because machines are known to have removable components for repair and maintenance reasons.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sinclair in view of Milnes (US Patent No. 4,438,323).

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Regarding claim 8, Sinclair discloses a electrically heated wedge, an alternative to that would be a wedge heated by resistive heating as disclosed in Milnes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the induction heating tool in Sinclair with a resistive heating tool, because the two types of heating are functionally equivalent alternative expedients of one another.

6. Claims 23-26 rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Sinclair.

Applicant admits that seaming methods utilizing irons and seaming tape is known in the art, but there is no teaching for having an iron which automatically drives the seaming iron at a predetermined rate.

Sinclair teaches using an automatically driven mechanism to advance a seam welder for roofing material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to automatically drive a seaming iron in the admitted prior, because automating a formally manual activity is known to an artisan. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.)

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Allowable Subject Matter

7. Claims 9 and 10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is an examiner's statement of reasons for allowance: There is no reason or suggestion for including a flexible line in Sinclair.


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
September 24, 2005